

REMARKS

Claims 2-7, 9-12 and 14-28 remain pending. Claims 10, 11, 14-17 and 22 are allowed. Claims 3, 12, 13, 18, 19, 20, 21, and 23-28 are rejected. Claims 2, 4-7 and 9 are objected to. The claims have been amended to improve the form thereof. Claim 13 has been canceled and the limitation thereof combined with claim 12.

The examiner has now, after five years of prosecution, withdrawn his previous rejections and rejected the claims based on Smith U.S. Patent No. 1,155,523 (1915). Claims 12, 13, 18, 23, 24, 19, 3, 20, and 27 are rejected as anticipated by Smith under 35 U.S.C. 102(b). Smith describes a "Device for Identifying Criminals and other Persons Through Combination Picture." The examiner equates the lower portion of the box shown in Figure 1 with the "base" and the walls of the box with wall sections. (The examiner refers to "5" but the patentee does not identify the box side walls by any number.) The inside of the box has a series of straps 6 which do appear to form grooves on which transparent plates are stored when the device is not in use. The examiner then states that these transparent plates have "designs" and are readable as wall panels which are slidably inserted into grooves, ending his review of claim 12 at that point. The reference goes on to describe that a photograph holder 14 is set on a metal plate 10 at the top of the box. Four hinged transparent frames 19, one per side, are provided which fold over plate 10 and holder 14. Each frame 19 can hold one of the transparent plates showing representations of wearing apparel, and is folded over to create the combination of the picture and the wearing apparel, when the device is viewed from the top.

The Smith reference does not anticipate any of the rejected claims, either before or after the current amendments. The present claims define a display system where the wall panel(s) are visible when mounted in the frame. The transparent plates of Smith are inserted onto straps 6 are inserted for storage purposes and hidden from view. The preambles of the rejected claims cannot be ignored. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). As discussed in MPEP 2111.02:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

As this example suggests, the preamble is meaningful in distinguishing a broadly claimed article from other different articles that made from similar components but fundamentally different in nature. Such is the case with Smith. Smith is attempting to create a composite picture by superimposing one image on another, not provide a modular display for creating a predetermined miniature environment such as a doll house. However, to make the differences more unmistakably clear, claims 12 and 19 have been further amended to expressly recite that the wall panels are in an upright position, like the walls, when inserted therein with the base on a horizontal surface. The panels of Smith in their storage position are horizontal, parallel to the base.

Claim 12 (with the limitation of claim 13 incorporated therein) requires recognizable subsets of wall panels with matching or coordinated decorative covers. These covers could take the form of painted or printed on markings, but even so Smith gives no indication of any subsets of plates with features in common. As to claim 19, plates inserted in storage positions in a box and viewable only from their ends, if at all (Smith Fig. 1), do not in any sense "cooperate to depict a predetermined miniature environment" as required by the claim. The remaining claims rejected under 35 U.S.C. 102 depend from claims 12 or 19 and are allowable for the foregoing reasons,

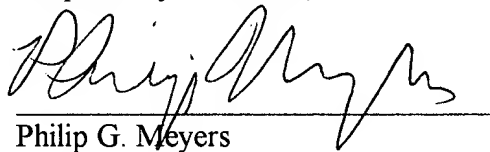
among others.

Claims 21, 25, 26 and 28 were rejected under 35 U.S.C. 103 on the basis of Smith in view of French U.S. Patent No. 5,261,849. There is no reasonable basis for such a combination.

Background scenery forms no part of identifying a criminal suspect, and the designs used on Smith's plates are limited to apparel which would alter the appearance of the person shown in the photograph. Placing the suspect against a puppet show background does not seem calculated to advance the cause of law enforcement. The rejection under 35 U.S.C. 103 should be withdrawn.

In view of the foregoing, applicants respectfully submit that the claims define patentable subject matter. A notice of allowance respecting all pending claims is, therefore, earnestly solicited. The examiner is invited to telephone the undersigned at the telephone number listed below if such would advance the prosecution of this application.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Philip G. Meyers", is written over a horizontal line.

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